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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,123	07/15/2003	Alois Schoenweger	3201-338 (D4700-00351)	7851
8933	7590	11/29/2007	EXAMINER	
DUANE MORRIS, LLP			GROSSO, HARRY A	
IP DEPARTMENT				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/620,123	<b>Applicant(s)</b> SCHOENWEGER, ALOIS	
	<b>Examiner</b> Harry A. Grosso	<b>Art Unit</b> 3781	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 7-10, 12 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-9, 17 and 18 is/are allowed.
- 6) ☒ Claim(s) 1-4, 10, 12, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 29, 2007 has been entered.

### ***Claim Objections***

1. Claim 16 is objected to because of the following informalities: The status identifier for claim 16 indicates it is "currently amended" However, it does not appear to have been amended from the previous submission. It appears the correct status identifier for claim 16 in this submission would be "previously presented" and it will be treated as such for the purposes of this action. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Humber, of record, in view of Chubb et al (5,326,060) (Chubb).

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1. Regarding claim 1, Humber discloses a flush-mounting box with an open front, an edge, sidewalls, a base (Figures 1- 4) and a flange (42). The device has plural means on the box (48) for fastening the flange and the flange can be fastened a variable distance from the front edge (column 2, lines 15-22). Plumbing elements can be installed within the box through openings (fittings) in the sidewalls (Figure 4).

Humber does not teach protruding eyes extending radially outward from the sidewalls adjacent to the base. Chubb discloses a flush-mounting box for plumbing elements (Figures 8 and 9) with eyes extending radially outward from the sidewalls adjacent to the base for mounting (15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of eyes extending from the sidewalls adjacent to the base as disclosed by Chubb in the box disclosed by Humber to provide an alternate means for mounting since this would constitute the combination of prior art elements to yield predictable results.

2. Regarding claim 2, Humber discloses the flange is a solid ring (Figure 1).

3. Regarding claims 4 and 12, Humber discloses the flange is fastened directly to the box from the open front of the box.

4. Regarding claim 15, Humber discloses the flange may be latched into position (column 2, lines 15-22).

5. Claims 1-4, 10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bossert in view of Lengyel, both of record.

6. Regarding claim 1, Bossert discloses a flush-mounted box with an open front (Figures 4 and 5), an edge (y), and a flange (a) on an outside of the box. The box has

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plural means (m) for fastening the flange to the box at variable distance back from the edge (page 1, lines 79-94). Plumbing elements can be installed within the box through openings (fittings) in the device created by removing typical knock-outs.

Bossert does not teach protruding eyes extending radially outward from the sidewalls adjacent to the base. Lengyel discloses a flush-mounting box with attachment means around the front opening and eyes extending radially outward from the sidewalls adjacent to the base for mounting (40, Figure 1, column 4, lines 46-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of eyes extending from the sidewalls adjacent to the base as disclosed by Lengyel in the box disclosed by Bossert to provide alternate means for mounting since this would constitute the combination of prior art elements to yield predictable results.

7. Regarding claim 2, the flange is a solid ring (Figure 1).
8. Regarding claim 3, the device has a plurality of structures spaced back from the edge at the open front on the outer surface of the sidewall for fastening the flange.
9. Regarding claim 4, the flange is fastened directly to the box.
10. Regarding claim 10, the joint between the box and the flange is a bayonet joint.
11. Regarding claim 16, Bossert discloses a flush mounting box that has an open front at edge (y), a plurality of grooves on the outside of the sidewalls of the box (m) at different distances from the edge and a flange (a) with inward protrusions (e) that engage the grooves.

***Allowable Subject Matter***

12. Claims 7-9, 17 and 18 are allowed.

***Response to Arguments***

13. Applicant's arguments with respect to rejection of claims 1, 2, 4, 12 and 15 over Humber and Lengyel have been considered but are moot in view of the new ground(s) of rejection.

14. Applicant argues that the Lengyel reference does not disclose the flush mounted device with a flange that can be fastened at variable heights by adjustment of any structure of Lengyel's box. In response, Lengyel is relied on to teach the use of protruding eyes on the base of the device for mounting of the device in combination with Bossert. Bossert discloses the remaining structure.

15. Applicant argues that Lengyel is used for mounting a device on a subfloor prior to pouring a concrete floor and is for a different purpose than applicant's device. In response, applicant is arguing intended use of the device. Lengyel is used to teach the structure of protruding eyes on the base of the device and, as such, meets the structural limitations required.

16. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

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*Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Bossert and Lengyel are analogous art and the combination of the mounting structure disclosed by Lengyel with the device disclosed by Bossert represents the combination of prior art elements to yield predictable results. It is reasonable to presume that the use of protruding mounting eyes on the base of a flush mounting box would be knowledge generally available to one of ordinary skill in the art.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry A. Grosso whose telephone number is 571-272-4539. The examiner can normally be reached on Monday through Thursday from 7am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on 571-272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Anthony Stashick  
Supervisory Patent Examiner  
Art Unit 3781

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